

ESTTA Tracking number: **ESTTA742925**

Filing date: **04/27/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058956
Party	Plaintiff SoCal Maico
Correspondence Address	KEN DALLARA LAW OFFICE OF KEN DALLARA 2775 TAPO STREET, SUITE 202 SIMI VALLEY, CA 93063 UNITED STATES kdallara@dallaralaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Ken Dallara
Filer's e-mail	kdallara@dallaralaw.com
Signature	/Ken Dallara/
Date	04/27/2016
Attachments	First part of Exhibits.pdf(3426431 bytes) Second part of Exhibits.pdf(3884195 bytes) Amended Petition-final.pdf(124131 bytes)

Int. Cl.: 12

Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

United States Patent and Trademark Office

Reg. No. 2,563,878

Registered Apr. 23, 2002

**TRADEMARK
PRINCIPAL REGISTER**

MAICO

SMITH, RONNIE S. (UNITED STATES CITIZEN)
2806 LARK DRIVE
OXFORD, AL 36203

FIRST USE 6-1-1981; IN COMMERCE 6-1-1981.

SER. NO. 78-068,391, FILED 6-11-2001.

FOR: MOTORCYCLES AND PARTS THEREFOR,
IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FLORENTINA BLANDU, EXAMINING ATTORNEY

Exhibit A

ORIGINAL SPECIMEN

Internet Transmission Date:

2001/06/11

Filing Date:

2001/06/11

Serial Number:

78068391

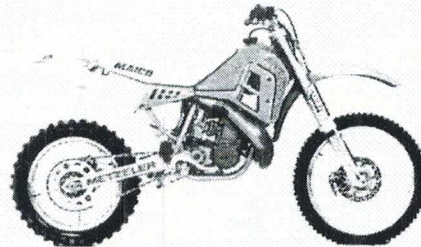


MAICO motorcycles come standard with the finest components available. Racers who buy most other brands have to purchase those separately.

- Mahle Pistons • Ranzthal Bars and Sprockets • Metzeler Tires
- UPO Plastic • White Power Shocks • Muller Fork
- Tsubaki Chain • Magura Adjustable Controls • Technoset Seat

New for 1992!

- New Cylinders with Coolant Passage Under Exhaust Port
- 320 now has compression release • Higher wattage Motoplat ignitions for lighting
- 500 has 2mm stroke increase for a full 499.5 cc
- New Muller "MDS" fork with unsurpassed adjustability
- New, more plush rear shock dampening • Magura adjustable control levers
- New "Dutch Power" exhaust pipes • New, quieter silencers
- Single piece coolant hoses (No T's or Y's to break)



MC500

SPECS	MC 250	GS 250	MC 320	GS 320	MC 440	GS 440	MC 500	GS 500
ENGINE	LIQUID COOLED, REED VALVE TWO STROKE WITH VARIABLE EXHAUST VALVE AND NIKASIL CYLINDER							
BORE X STROKE	67 mm x 70 mm		76 mm x 70 mm		82 mm x 83 mm		86.5 mm x 85 mm	
DISPLACEMENT	247 cc		318 cc		438 cc		499.5 cc	
CARBURETOR	BING V64 ø 40 MM OVAL BORE							
IGNITION	MOTOPLAT INTERNAL		MOTOPLAT EXTERNAL WITH 12V 110W LIGHTING COIL					
EXHAUST	HIGH PIPE MADE BY DUTCH POWER OF HOLLAND WITH EXTRA QUIET REGULABLE ALUMINUM SILENCER							
TRANSMISSION	5 SPEED DOG SHIFTING RUNNING ON NEEDLE AND BALL BEARINGS							
RATIO	CLOSE	WIDE	CLOSE	WIDE	CLOSE	WIDE	CLOSE	WIDE
PRIMARY DRIVE	STRAIGHT CUT GEARS							
FINAL DRIVE	13T / 52T	15T / 50T	13T / 52T	15T / 50T	15T / 50T	15T / 50T	15T / 52T	15T / 50T
DRIVE CHAIN	520 x 116 LINK TSUBAKI OMEGA O-RING TYPE							
FRAME	CHROME MOLY SINGLE LOOP SPLIT TO DUAL LOWER TUBES							
FRONT SUSPENSION	MULLER MDS UPSIDE DOWN FORK WITH EXTERNAL ADJUSTMENTS TO HIGH SPEED COMP. / LOW SPEED COMP. / REBOUND DAMPENING 12" TRAVEL							
REAR SUSPENSION	MAICO TWIN LINK PROGRESSIVE LINKAGE WITH WHITE POWER SHOCK WITH EXTERNAL ADJUSTMENTS TO COMPRESSION AND REBOUND DAMPENING ALUMINUM BOX SECTION SWING ARM 13.5" TRAVEL							
FRONT BRAKE	GRIMECA TWIN PISTON FLOATING CALIPER ON 9.25" ø DISC - MAGURA MASTER CYLINDER							
REAR BRAKE	GRIMECA SINGLE PISTON FLOATING CALIPER ON 9.25" ø DISC - MAGURA MASTER CYLINDER							
FRONT TIRE	METZELER 3.00 - 21							
REAR TIRE	METZELER 110 / 90 - 18				METZELER 120 / 90 - 18			
FUEL CAPACITY	2.1 GAL	3.1 GAL	2.1 GAL	3.1 GAL	2.1 GAL	3.1 GAL	2.1 GAL	3.1 GAL
WHEEL BASE	58.5" - 60.0"							
GROUND CLEARANCE	15.1"							
SEAT HEIGHT	37.8"							
DRY WEIGHT	215 lbs.	218 lbs.	218 lbs.	219 lbs.	223 lbs.	224 lbs.	225 lbs.	226 lbs.

MAICO GS models offer the same features of the motocross MC models except for wide ratio gearboxes and a larger 3.1 gallon tank. All models except MC250 come with external flywheel ignition with 12V 110W lighting coil.

For full Enduro equipment, we offer an optional kit consisting of Acerbis headlight and taillight fender, spark arrestor, aluminum side stand and handlebar guards.

U.S. MAICO
2806 Lark Dr.
Oxford, AL 36203
TEL (205) 831-3029
FAX (205) 831-3029

YOUR MAICO DEALER:

The applicant has submitted required color specimen. The USPTO has printed only one copy of the specimen, and extra copies can be produced in-house as needed.

Exhibit B

U.S. MAICO® L.L.C.

3212 Hwy 21 South, Oxford, Alabama 36203 USA
Tel: 256-831-3029 Fax: 256-831-3519 E-mail: ronnie@usmaico.com
www.usmaico.com

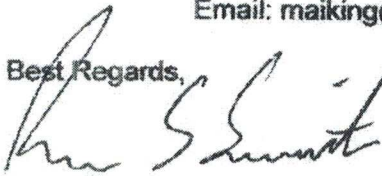
January 3, 2006

To all Maico Motorcycle Dealers,

Effective January 1, 2006, Eric Cook of Maico Only has purchased U.S. Maico, LLC and all its assets. We appreciate all of your patronage over the past years and encourage you to contact Maico Only for all of your Maico needs.

Maico Only
1601 S. Cucamonga Ave.
Ontario, CA 91761
Phone: (909)947-1121
Fax: (909)947-6620
Email: maiking@earthlink.net

Best Regards,



Ronnie S. Smith

Exhibit C



1825 Lake Pl
Ontario, CA 91761
(909) 947-1121

Invoice

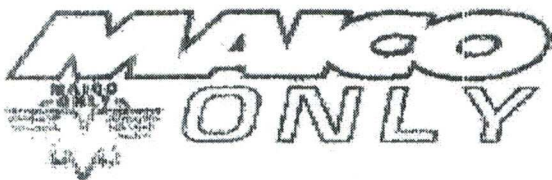
DATE	INVOICE #
8/30/1999	27

BILL TO	SHIP TO
John Caldwell 4124 torquay dr victoria, BC CANADA v8n3k9	john caldwell 1733 h.st ste 330a blaine, wa. 98230.

			TERMS	SHIP VIA
			Due on receipt	US Mail
PART NO.	DESCRIPTION	QTY	RATE	AMOUNT
12-1203b	progressive shocks 13.5, 12 series Out-of-state sale, exempt from sales tax	1	140.00 0.00%	140.00T 0.00
			Total	\$140.00

Returns are subject to a 20% restocking Fee

Exhibit D



1825 Lake Pl
Ontario, CA 91761
(909) 947-1121

Invoice

DATE	INVOICE #
11/15/2000	628

BILL TO	SHIP TO
John Caldwell 4124 lorquay dr victoria, BC CANADA v8n3k9	john caldwell 1733 h.st ste 330a blaine, wa. 98230.

				TERMS	SHIP VIA
				credit card	
PART NO.	DESCRIPTION	QTY	RATE	AMOUNT	
06792	gasket, 81-83 250 head gasket	1	15.88	15.88T	
08224	base gasket, 83-on .5mm	1	6.82	6.82T	
01964	FLYING M TANK DECAL SMALL	2	4.00	8.00T	
08021	center case gasket, 250 83-on	1	6.82	6.82T	
08023	clutch gasket 83-84	1	7.20	7.20T	
08187	83-84 shift shaft	1	82.60	82.60T	
	Out-of-state sale, exempt from sales tax		0.00%	0.00	
			Total	\$127.32	

Returns are subject to a 20% restocking Fee

Exhibit D



1825 Lake Pl
Ontario, CA 91761
(909) 947-1121

Invoice

DATE	INVOICE #
9/27/2007	6352

BILL TO	SHIP TO
CANADIAN MAICO 4124 TORQUAY DR VICTORIA B.C V8N3K9 CANADA	CANADIAN MAICO 4124 TORQUAY DR VICTORIA B.C V8N3K9 CANADA

TERMS	SHIP VIA
Due on receipt	US Mail

PART NO.	DESCRIPTION	QTY	RATE	AMOUNT
01965	flying m tank decal small	4	3.75	15.00
12340	shipping /handling	1	8.00	8.00
	Out-of-state sale, exempt from sales tax		0.00%	0.00
			Total	\$23.00

Returns are subject to a 20% restocking Fee

Exhibit D



1825 Lake Pl
Ontario, CA 91761
(909) 947-1121

Invoice

DATE	INVOICE #
12/1/2009	8279

BILL TO	SHIP TO
CANADIAN MAICO 4124 TORQUAY DR VICTORIA B.C V8N3K9 CANADA	CANADIAN MAICO 4124 TORQUAY DR VICTORIA B.C V8N3K9 CANADA

			TERMS	SHIP VIA
			Due on receipt	US Mail
PART NO.	DESCRIPTION	QTY	RATE	AMOUNT
mor7973 12340	MOR AIR BOOT 83-84 ALL	10	20.00	200.00
	shipping/handling	1	22.50	22.50
	Out-of-state sale, exempt from sales tax		0.00%	0.00
			Total	\$222.50

Returns are subject to a 20% restocking Fee

Exhibit D



1825 Lake Pl
Ontario, CA 91761
(909) 947-1121

April 11, 2016

I, Eric Cook, have been using all Maico trademarks continuously in commerce since 1996.

A handwritten signature in black ink, appearing to read "Eric Cook". The signature is fluid and cursive, with a long, sweeping underline that extends to the right.

Exhibit E

MAICOWERKS

VINTAGE MAICO PARTS

REPAIR SERVICE RESTORATIONS CUSTOM BIKES

Home Page

CABLES

CONTROLS

FENDERS

SIDEPANELS

PLASTIC

TRICK/RACE ITEMS

NEW ENGINE PARTS

USED PARTS

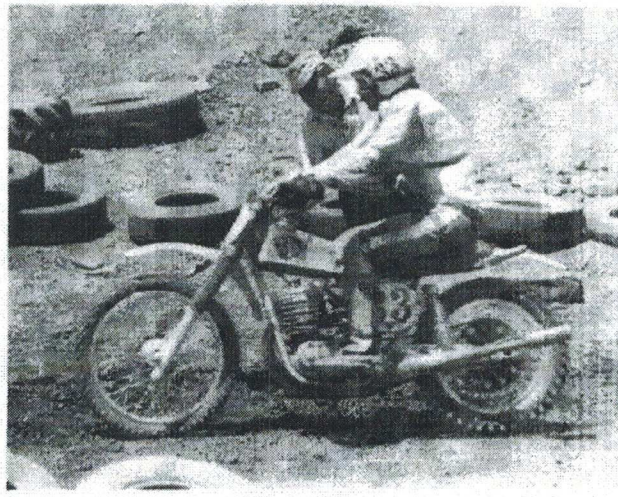
TOOLS


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SHOP DOG

BIKES FOR SALE

MAICOWERKS.COM



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Welcome to our website

MAICOWERKS

Parts, service, and restoration service for the best bikes ever made!

I've been racing and building Maicos for over 35 years.

Please call for any questions, or help with a problem. We're

open Monday-Saturday 9-5pm PST. We also accept Mastercard, Visa,

American Express or Paypal. We ship daily via UPS.

Contact Jeff @ 408 431-1499

Email @ jeff@maicowerks.com

Exhibit E



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Northwest Maico and CZ | 322 East Allen Street Suite D, Meriden, PA 17055, USA Phone: 717-458-3635 | Fax: 717-458-3644

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Yamaha

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Maico

Our Products: Maico

MAICO

Maico—"Maisch and Company"—was founded by Ulrich Maisch in Poltringen, Germany in 1926. Ulrich first operated the business as a 24-hour automobile service center, and sold bicycle and motorcycle parts as well. When Ulrich's sons Wilhelm and Otto joined the business, they soon began assembling complete bicycles for sale, and by 1935 produced their first motorized two-wheeler. Maico was nationalized by the German government during World War II and made to manufacture airplane parts and other war material. Following the war, Maico found itself fortunate to be in Allied-controlled West Germany, and again began producing motorcycles. The company thrived during the 1950s, and began to earn a reputation for producing motorcycles that "were just a little bit better" than the BMWs, Adlers, Kreidlers, NSUs, and other German machines then available, according to German engineer and racer Eric Bley. Maico helped pioneer the production of high-performance two-stroke engines, and mated their power-plants with well-designed, high-quality chassis. It was also during the 1950s that Maico gravitated towards the manufacture of off-road motorcycles, rather than street bikes. As the 1960s began, Maico was well-positioned to supply sporting motorcycles for the growing world of off-road motorcycling. Maico continued to be recognized as an elite brand for enthusiasts. Maico's design for leading-axle front forks, with the upper tubes mounted in the triple-tree, nearly in-line with the steering stem, lessened the mechanical advantage of the front wheel in favor of the rider's strength, and created the only "front-steering" dirt bike in the world for the next two decades. In America in the mid-to-late sixties, with distributors Frank Cooper in place on the west coast and Dennis Moore on the east coast, Maico took off as the elite machine for the newly-imported sport of "moto-cross." Likewise, in Europe in 1972, the word on the international motocross circuit was that if you wanted to win, you needed to be on a Maico. Maico in 1973 was at the center of the introduction of the biggest innovation to ever hit off-road motorcycles: long-travel suspension. Clearly aware of Yamaha's mono-shock efforts, but also acting independently, Maico race-team engineer Reinhold Weiher introduced the twin-shock long-travel rear suspension at the Czech Grand Prix of that year. Maico immediately realized the importance of their discovery, and were quick to share it with every other Maico rider. The company put their long-travel machine into production in early 1974, the famous "1974 1/2" model. Maico engineers were responsible for a litany of industry accomplishments. Among them were the iconic Maico 501; the bullet-fast but fragile 125s—both road-racing and off-road versions; the amazingly-competent MC400 and MC440 machines; and the motorcycle often regarded as "the best motocross bike, for its time, ever made:" the 1981 Maico 490. As former Maico employee—and now KTM vice-president—Selvaraj Narayana points out, Maico engineers produced the basic geometry and layout for every modern dirt bike, with the introduction of the great 490. Maico's pre-eminence in off-road motorcycles ended with the company's sudden—and for years, baffling and mysterious—bankruptcy in 1983. Riders associated with the Maico name include Swedish legend Ake Jonsson. Jonsson's perfect riding, paired with his Maico 400 in the 1972 European and American series, made every other man and machine combination appear inferior. German stars Adolf Weil, Willi Bauer, and Hans Maisch were extremely loyal Maico riders. American champions often associated with Maico include Tim Hart, Gary Chaplin, Rex Staten, Rich Eirstedt, Steve Stackable, Gaylon Mosier, Denny Swartz, and Danny "Magoo" Chandler. Designer/fabricator Greg Smith (founder of WheelSmith Engineering) and Rick "Super Hunky" Sieman (founder and editor of DIRT BIKE Magazine) are also closely associated with Maico.

Browse these categories under "Maico"

125cc Engine	250cc Engine	360/400cc Engine
440cc Engine	490cc Engine	Air Filters
Billet Parts	Brakes	Chassis/Frame
Controls	Decals/Graphics	Electrical System
Exhaust System	Fuel System	Hubs & Wheels
Plastic Parts	Sprockets & Chain	Suspension
Tools		

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Exhibit E

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About Us

Since 1990, Northwest Maico and CZ, LLC has made no compromise in our commitment to provide the highest quality parts and accessories for Maico and CZ motorcycles. What began as a hobby has now evolved into one of the largest inventories in the nation. All of us at Northwest Maico and CZ, LLC use the products that we design and manufacture.

In 2012, Northwest Maico and CZ, LLC expanded the product line to include Suzuki and Yamaha parts and accessories. For additional product information from Northwest Maico and CZ please check out the rest of our site or call 717-458-8639.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re Registration Number : 4,156,487
Opposition Filing Date : March 4, 2015
Opposition Number : 92/058956
Registered Marks : MAICO DESIGN MARK

GARY KORTZ

Opposer,

v.

578539 B.C. LTD,
TA CANADIAN MAICO

Mark's Registered Owner,

OPPOSER'S FIRST AMENDED
PETITION FOR CANCELLATION

Commissioner for Trademarks
Attention : Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

OPPOSER'S FIRST AMENDED PETITION FOR CANCELLATION

Opposer , Gary Kortz, by his attorney, Ken Dallara, Attorney at Law, submits this First Amended Petition to his original petition dated April 1, 2014 filed with the Trademark Trial and Appeal Board as directed by this Board in response to 578539 B.C. LTD, TA CANADIAN MAICO Motion for Judgment on the Pleadings. Opposer's submits the following Amended Answer :

1. 578539 B.C. LTD, TA CANADIAN MAICO ("CANADIAN MAICO") is the alleged owner of Federally Registered Trademark under Registration No 4,156,487 for the trademark M MACIO and Designs associated therewith said MAICO Mark ("MAICO MARK"), Canadian Maico having applied for said Mark on January 11, 2011.

2. CANADIAN MAICO allegedly filed U.S. Trademark Application Serial No. 85/222,759 (the

“Application”), which is the subject of this Cancellation , on January 21, 2011 , based on its purported use of the design mark “MAICO” in connection with “Motorcycles for Motocross” in International Class 12.



3. CANADIAN MAICO alleges that the first use of the Mark anyway occurred on December 1, 2002 and their first use in commerce occurred on December 1, 2002.
4. Opposer operates a MAICO distributorship named SOCAL MAICO, said distributorship operating continually from January of 2009.
5. Opposer filed his Petition for Cancellation on April 1, 2014 alleging Genericness, Likelihood of Confusion, Deceptiveness, False suggestion of a connection and *Torres v Cantine Torresella S.r.l* Fraud.
6. Opposer has been granted the right to amend his petition based solely on the Likelihood of Confusion and Ownership grounds.

OPPOSER HAS STANDING AS AN AFFECTED THIRD PARTY TO REGISTRATION OF A
MARK

7. Opposer has standing to bring this action as he will be directly affected by the continued registration of the MAICO Mark. A plaintiff need not assert proprietary rights in a term in order to have standing. *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1496 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); For example, when genericness of the mark is in issue,

Opposer may plead (and later prove) its standing by alleging that it is engaged in the sale of the same or related products or services and that the opposer has an interest in using the term descriptively in its business. That is, opposer may plead that it is a competitor. *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999) states that an “opposer has standing where opposer is a competitor in the industry, a direct competitor of applicant, and one who used the mark at issue on or in connection with its product”.

CANADIAN MAICO CAN NOT ESTABLISH AN OWNERSHIP INTEREST IN THE MAICO
MARK AS THERE HAS BEEN CONTINUOUS USE BY OTHERS PRIOR TO
REGISTRANTS FIRST DATE OF USE

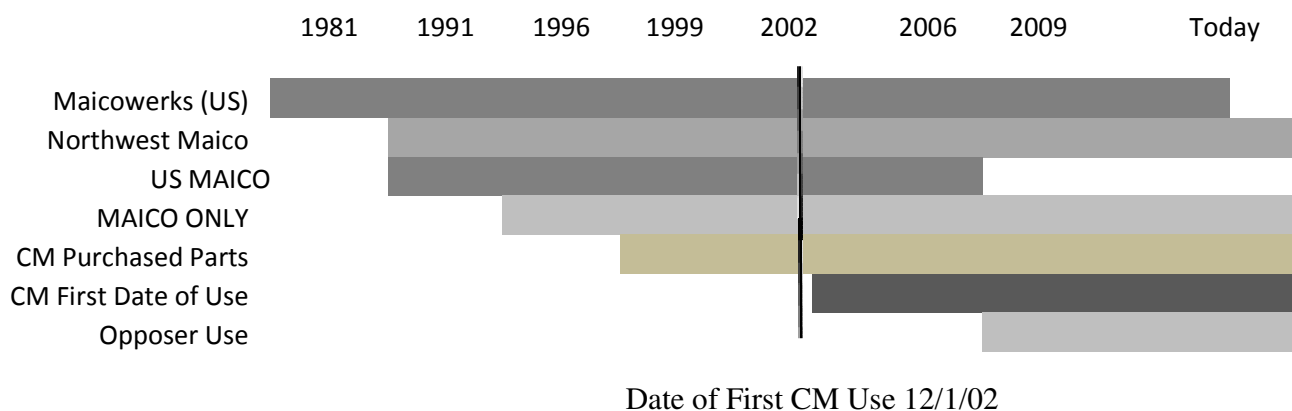
8. Opposer alleges that the “MAICO” plain word portion of the alleged CANADIAN MAICO Mark refers to motorcycles made from 1926 to 1986 by Maicowerk A.G. in West Germany and sold into the United States as early as 1969 that bear the MAICO name and logo. Opposer also alleges that the Stylized Logo registered by CANADIAN MAICO was also used prior to 1969, though the exact date is uncertain at this time. Though Maicowerk A.G. went bankrupt in or about 1983, Maico Motorcycles has had a succession of company owners who have produced Motorbikes, Motorbike accessories and Motorbike parts for distribution throughout the world and in particular in the United States. The alleged CANADIAN MAICO Mark has been in use by Maicowerk A.G. as well as the subsequent owners in the exact form or one closely resembling the Mark in the United States since at least 1969.
9. Since at least 1981, MAICO Motorcycle parts and accessories have been sold by a variety of retailers and wholesalers, said parts and accessories being sold under the MAICO name and some bearing the MAICO design Mark allegedly registered by CANADIAN MAICO.
10. In or about 1991, Mr. Ronnie Smith, allegedly became the sole authorized distributor of MAICO Motorcycles, under the company name of US MAICO, for MAICO motorcycles, parts and

accessories in the United States, under authorization from the German company who had purchased the Maicowerk A.G. out of bankruptcy.

11. Mr. Smith on or about June 11, 2001, allegedly proceeded to file for and obtain Federal Trademark 2,563,878 ('878 Mark) for AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) IN STYLIZED FORM with the word MAICO, claiming use in commerce from June 1, 1981. (Federal Registration attached as Exhibit A). It is critical to note that the Specimen presented to this Office by Mr. Smith showed use of the exact same stylized Logo the CANADIAN MAICO is now claiming. (Exhibit B)
12. In January of 2006, Mr. Smith allegedly sold all of the assets of US MAICO to Mr. Eric Cook of MAICO ONLY (Exhibit C), and Mr. Cook has continued to use the MAICO Marks. In fact, CANADIAN MAICO has continued to purchase his parts from Mr. Erick Cook of MAICO ONLY as well as a host of other retailers, all of whom pre-date CANADIAN MAICO.
13. CANADIAN MAICO first started purchasing MAICO parts and accessories from Mr. Cook since 1999 and became a parts dealer under MAICO ONLY in or about September of 2007. (Exhibit D)
14. Mr. Cook and others have allegedly continually used the Mark in commerce since prior to 1996 (Exhibit E) . [T]he right to a particular mark grows out of its use, not its mere adoption. . . .” The use requirement remains one of the most firmly imbedded principles in all of U.S. trademark law, and use in commerce is a cornerstone of the Lanham Act. 28 - *United Drug Co. v. Rectanus Co.*, 248 U.S. 90, 97 (1918).
15. Table below shows various companies first of date of use of the MAICO Mark and name which shows that not only was the use continuous since 1981 through today but that CANADIAN MAICO does not have any superior ownership claim as ownership is predicated on use. “A party

can acquire protectable trademark rights only through use of the mark in connection with its product and where that use predates the continual use by others. *Specht v. Google Inc.*, No. 11-3317 (7th Cir. 2014), quoting *New West Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 1200 (9th Cir. 1979)). It is impossible for CANADIAN MAICO to assert any ownership rights as Maicowerks US, Northwest Maico, US MAICO, and MAICO ONLY's use predates CANADIAN MAICO's use in commerce.

FIRST DATE OF USE OF CANADIAN MAICO (CM) USE AS RELATED TO OTHER SUPERIOR USERS FIRST DATE OF CONTINUOUS USE



Opposer alleges that due to the continuous use by MAICO ONLY, who have appropriated the mark and "use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of [the adopter of the mark]." (*Specht v. Google Inc.*, No. 11-3317 (7th Cir. 2014), quoting *New West Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 1200 (9th Cir. 1979)).

16. Opposer alleges that there any many companies who have superior rights to the MAICO Mark and have used the name as MAICO in describing their Motorcycle parts, in the manufacturing of parts for MAICO Motorcycles as well as in the sale of MAICO decals and merchandise.

17. Opposer alleges that ownership of the Mark lies between the superior users who have used the Mark prior to December 1, 2002, the date of first use by CANADIAN MAICO. Ownership is key to registration and standing to assert their rights.

FAILURE TO ACHIEVE OWNERSHIP WILL ALSO
VOID TRADEMARK REGISTRATION

18. The ownership [of a Mark] is a material fact that the PTO would rely upon when deciding whether to grant a trademark. *STROME v. DBMK ENTERPRISES, INC. USDC, N.D. California. November 19, 2014.*
19. Specifically, pursuant to TMEP Section 1201.02(b), “[a]n application based on use in commerce under 15 U.S.C. 1051(a) must be filed by the party who owns the mark on the application filing date. If the applicant does not own the mark on the application filing date, the application is void.” TMEP § 1201.02(b) (emphasis added) (citing 37 C.F.R. 2.71(d); *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) and *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235 (TTAB 2007))
20. Opposer alleges that CANADIAN MAICO cannot “own” the MAICO Mark as they are merely junior rights holders to the senior rights holders who have used the Mark in commerce for decades prior to CANADIAN MAICO’s first use. Use predicates rights!

MARK WAS NEVER ABANDONED THROUGH NON-USE

21. The ‘878 Mark was cancelled for failure to file Section 8 Declarations of Use in January of 2009, said failure was due to Mr. Cook’s naivety as to the required maintenance of the MAICO Trademark that he had been using since the purchase of all of the assets of US MAICO.
22. Unintentional failure to maintain registration does not abandon the Mark.

“It is fundamental that ownership of a mark is acquired by use, not by registration. One must be the owner of a mark before it can be registered. The right to use is unaffected either by failure to register or expiration of a registration. Not even the right to exclude is

obtained from registration of trademarks and service marks. *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319, n. 6, 189 USPQ 630 (1976)

Opposer alleges that MAICO ONLY, a supplier of MAICO products to the Opposer, has continual use of the MAICO Marks not affected by the alleged abandonment of the Federally Registered Mark.

23. Though the '878 Mark was cancelled, Mr. Cook and others have allegedly been using the MAICO Marks since his purchase of the assets of US MAICO.

24. Mr. Cook was not familiar with the need to have the trademark registration transferred over to MAICO ONLY after the sale, but lack of assignment also does not negate his ownership thereof.

The Board has held that "[n]either a formal assignment nor recordation of an assignment in the Patent and Trademark Office is necessary to pass title or ownership to common law or statutory trademark rights." *American Manufacturing Co. v. Phase Industries, Inc.*, 192 USPQ 498, 500 (TTAB 1976)

ALTERNATIVELY, EVEN IF MARK WAS ABANDONED THROUGH NON-USE BY
ORIGINAL OWNER, MARKS FALLS TO THE PUBLIC DOMAIN AND USE
PRIORITIZES OWNERSHIP

25. Specifically, it appears the CANADIAN MAICO may try to show that US MAICO abandoned its trademark, invoking the principle that where "an owner ceases to use a mark without an intent to resume use in the reasonably foreseeable future, the mark is said to have been 'abandoned.' . . .

[BUT] Once abandoned, a mark returns to the public domain and may, in principle, be appropriated for use by other actors in the marketplace . . . in accordance with the basic rules of trademark priority." It is axiomatic in trademark law that the standard test of ownership is priority of use." *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 147 (2d Cir. 2007) (internal citations omitted)

26. The first party to use an abandoned trademark in a commercially meaningful way after its abandonment, is entitled to exclusive ownership and use of that trademark."; *General Cigar Co.*,

Inc. v. G.D.M, Inc., 988 F. Supp. 647, 658 (S.D.N.Y. 1997). CANADIAN MAICO believes that he who is first to file gets the Mark, but it is USE not FILING STATUS that controls ownership. “It is fundamental that ownership of a mark is acquired by use, not by registration...” The right to use is unaffected either by failure to register or expiration of a registration. *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319, n. 6, 189 USPQ 630 (1976)

27. Thus, so long as a person is the first to use a particular mark to identify his goods or services in a given market after abandonment, and so long as that owner continues to make use of the mark, he is "entitled to prevent others from using the mark to describe their own goods" in that market. *Defiance Button Mach. Co. v. C & C Metal Prods. Corp.*, 759 F.2d 1053, 1059 (2d Cir.1985); see also *Sengoku Works v. RMC Int'l*, 96 F.3d 1217, 1219 (9th Cir. 1996). As the table shows, CANADIAN MAICO is not the first to use, and thus has no ownership rights to prevent others from using the Mark.

LIKELIHOOD OF CONFUSION

28. As alleged, CANADIAN MAICO, is a relative newcomer to the MAICO scene. As alleged, there are several companies, picked out of many, that have used the Mark since 1981 at least.

29. "The first to use a mark is deemed the `senior' user and has the right to enjoin `junior' users from using confusingly similar marks in the same industry and market or within the senior user's natural zone of expansion.". *Sebastian Brown Productions LLC V. Muzooka Inc.*, Case No. 15-CV-01720-LHK United States District Court, N.D. California, San Jose Division. March 14, 2016.

30. However, actual sales are not necessary to establish trademark rights. Rather, the party seeking trademark right must show appropriation of the mark and "use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of

[the adopter of the mark].'" (*Specht v. Google Inc.*, No. 11-3317 (7th Cir. 2014), quoting *New West Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 1200 (9th Cir. 1979)). MAICO ONLY, amongst others, have adopted the Mark in the Motorcycle segment of commerce and have used the MAICO Marks in commerce to identify the Motorcycle Parts and accessories as having a particular brand of quality, sizing and fit as the original MAICO motorcycle parts and accessories had obtained.

31. The federal courts use the Sleekcraft factors as a guide and apply them on a case-by-case basis with some variation. The common factors considered by courts are: (1) strength of the mark; (2) degree of similarity of the goods or services; (3) degree of similarity of the marks; (4) evidence of actual confusion; (5) use of the Internet as marketing channels; (6) use of the Internet as marketing channels; (7) the alleged infringer's intent in selecting the mark; and (8) likelihood of product lines expansion.. *AMF Inc. v. Sleekcraft Boats*, 599 F. 2d 341 – 1979. Consumer confusion will be rampant should CANADIAN MAICO be allowed as a junior user to register the MAICO MARK . The consumer of MAICO products will now be confused as to the source of goods that bear the same MAICO Mark. Opposer alleges that CANADIAN MAICO's Goods do not necessarily measure up the standards of the original MAICO brand.

- a. Strength of Mark - Since there are more than 1,000 MAICO Motorcycles and hundreds of thousands of MAICO Motorcycle Parts that are in commerce currently bearing the MAICO MARKS, how will the consumer know which parts are original, re-manufactured or manufactured by whomever if they all bear the EXACT SAME MARK? The Mark is unique and even though not currently being produced, enjoys a cult like following of devotees to the MAICO brand of Motorcycle.

- b. Degree of Similarity of Goods - Due to the need to have 100% fit, form and function for all parts manufactured for MAICO motorcycles, the goods are EXACTLY the same, some bearing the EXACT same MAICO logo. The consumer has absolutely no means to discover the actual source of goods by looking at the Part that bears the MAICO Mark. Opposer alleges that due to inferior casting of parts by CANADIAN MAICO, that the consumer will be confused into purchasing inferior parts that bear the MAICO Mark if CANADIAN MAICO has sole use of the Mark.
- c. Degree of Similarity of Mark – CANADIAN MAICO’s Mark is the EXACT SAME Mark as the Mark that is currently on thousands of motorcycles, parts and accessories. The consumer has method to discern which parts come from which source of goods. In fact, CANADIAN MAICO is trading on that goodwill to control the market.
- d. Use of the Internet as marketing channels – Since very few companies exists as brick and mortar stores, sales are almost exclusively done on the Internet. Since there exists a huge stockpile of goods that bear the MAICO Logo, that are not associated with CANADIAN MAICO, there is no method available to ascertain the source of goods as the goods are exactly the same and so are the MAICO Marks.
- e. Alleged infringer’s intent in selecting the mark – CANADIAN MAICO has already attempted to remove Opposer’s website from the Internet as well as allegedly taken to various blogs stating that he is the ONLY source for MAICO products. His intent is to seize upon the good will of the MAICO Mark and to have the MAICO community beg at the bully’s feet.

32. The alleged CANADIAN MAICO Marks will create a likelihood of confusion by creating a false sense that CANADIAN MAICO has some form of ownership, dominion and control over the

MAICO brands and associated Marks. Furthermore, the consumer will be confused into believing that CANADIAN MAICO is the only authorized reseller of MAICO Motorcycles, parts and accessories and that CANADIAN MAICO use of the Marks is authorized by the successor owners of the MAICO Motorcycle Company. CANADIAN MAICO would have the potential to force the closure of businesses, including the Opposer, some of whom have been in operations for decades prior to CANADIAN MAICO's existence, by demanding licenses and royalties for goods that are already in commerce today!

THEREFORE, Opposer respectfully requests that Opposer's Amended Petition for Cancellation be granted and that Registration Number 4,156,487, be cancelled; and

FURTHERMORE, that this cancellation proceeding be used as res judicia or issue preclusion regarding Canadian Maico's ownership rights to any preexisting MAICO Motorcycle name, logo or likeness thereof.

Respectfully submitted,

/Ken Dallara/

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Dated : April 27, 2016

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CERTIFICATE OF SERVICE

1) I hereby certify that a copy of the OPPOSER'S FIRST AMENDED PETITION was caused to be transmitted to the Trademark Trial and Appeal Board via the ESTTA electronic filing system on 4/27/16.

2) I hereby certify that a copy of the OPPOSER'S FIRST AMENDED PETITION was served upon aforementioned counsel by depositing it with the United States Post Office, postage prepaid, on 4/27/16 via First Class Mail to the following recipient:

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By : _____/Ken Dallara/
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